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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re reissue application of
Horace L. Freeman *et al.*
Application No. 08/335,981
Filed: November 8, 1994
For: U.S. Patent No. 5,088,484

In re Horace L. Freeman *et al.*
Reexamination Proceeding
Control No. 90/003,586
Filed: October 3, 1994
For: US. Patent No. 5,088,484

DECISION SEVERING PREVIOUSLY MERGED REISSUE APPLICATION AND *EX PARTE* REEXAMINATION PROCEEDING

The merged proceeding consisting of reissue application 08/335,981 and *ex parte* reexamination proceeding 90/003,586 is before the Office of Patent Legal Administration for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,088,484 (the '484 patent) issued to Horace L. Freeman *et al.* on February 18, 1992 with 33 claims.

2. On October 3, 1994, a request for *ex parte* reexamination of the '484 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 90/003,586 (the '586 reexamination proceeding).

3. On November 8, 1994, the patent owner filed a reissue application based on the '484 patent, which was assigned Application Number 08/335,981 (the '981 reissue application). The filing was accompanied by a preliminary amendment narrowing independent claims 1 and 15 and adding claims 33-42 in an attempt to provoke an interference with U.S. Patent No. 5,342,291 issued to Matthew T. Scholz *et al.* August 30, 1994.

4. On December 22, 1994, an order granting the reexamination request was mailed for the '586 proceeding.

5. The Office merged the '981 reissue application and the '586 reexamination proceeding into a single combined proceeding, in a merger decision mailed August 11, 1995.

6. The August 11, 1995 merger decision required, *inter alia*, that the specification and claims of the merged reissue application and reexamination proceeding be maintained as identical by the filing of identical amendments for so long as the reissue application and reexamination proceeding remained merged.

7. On August 22, 1995, a housekeeping amendment was filed in the '586 reexamination proceeding, which resulted in the specification and claims of the '586 reexamination proceeding being identical to the specification and claims of the '981 reissue application.

8. On September 22, 1999, the Board of Patent Appeals and Interferences (Board) rendered a decision on appeal reversing all outstanding rejections of record against pending claims 1-42 of the merged proceeding.

9. On April 18, 2006, an Initial Interference Memorandum was forwarded to the Board regarding the '981 reissue application.

APPLICABLE STATUTORY AND REGULATORY PROVISIONS

35 U.S.C. § 305 states in pertinent part:

> "No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, **will be conducted with special dispatch** within the Office." [Emphasis added.]

37 CFR 1.565(d) and (e) state:

> "(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will **normally** be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to

[1] See 47 CFR 41.102, and the discussion in MPEP § 2303, Eighth Edition, Rev. 4, October 2005.

both the reissue application and the *ex parte* reexamination proceeding and be physically entered into both files...."

" (e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§ 41.121(a)(3) of this title) to suspend the interference has been presented to, and denied by, an administrative patent judge, and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set...." [Emphasis added.]

37 CFR 1.550(a) and (g) provide, in pertinent part,

(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered.

DECISION

The April 18, 2006 forwarding of the Initial Interference Memorandum to the Board regarding the '981 reissue application is a representation that examination has been completed and all pending claims have been allowed, finally rejected or canceled, and that appeal from a final rejection has been completed including any judicial review. [2] The record accordingly shows that the instant merged proceeding has progressed to the point where all claims appear to be allowable, save for a question of priority of invention that has been referred to the Board for resolution in an interference proceeding.

Conducting an interference proceeding while the '981 reissue application and the '586 reexamination proceeding remain merged as a single combined proceeding would result in a lengthy delay of the conclusion of the present reexamination proceeding. This would run counter to the statutory mandate of 35 U.S.C. § 305 that the reexamination proceeding be conducted with special dispatch. Further, the conduct of an interference proceeding is, by its nature, an *inter partes* proceeding. If the '981 reissue application and the '586 *ex parte* reexamination proceeding remain merged as a single proceeding, this would raise a question of whether the '692 reexamination proceeding were in fact being conducted as an *ex parte* proceeding as is required by the statute, which requirement is implemented in 37 CFR 1.565 (g). *See Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989). [3]

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[2] See 47 CFR 41.102, and the discussion in MPEP § 2303, Eighth Edition, Rev. 4, October 2005.

[3] In *Syntex*, the court said (paragraph bridging pages 1868 & 1869):

"If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. **Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination.** See 35 U.S.C. §305 ("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination"). Thus, a reexamination is conducted *ex parte* after it is instituted. See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), cert. denied, 474 U.S. 828 (1985)." [Emphasis added in bold]

It is therefore determined that the most expeditious avenue to satisfy the special dispatch requirement of 35 U.S.C. § 305 and, at the same time, expedite resolution of the question of priority of invention raised by the Initial Interference Memorandum, is to sever the merged proceedings and take action on the '981 reissue application and '586 reexamination proceeding separately and concurrently.

Accordingly, the following action is taken:

Jurisdiction over the '586 reexamination proceeding is being returned to the Technology Center for immediate action on the proceeding by the primary examiner. In the event that the pending claims in the '586 reexamination proceeding have been impermissibly broadened pursuant to the guidelines in MPEP § 2258(III)(A) and contrary to 35 U.S.C. § 305, appropriate action should be taken to eliminate such broadening.[4] After any issue of any broadening has been resolved, if the claims remain in condition for confirmation/allowance, the preparation of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate pursuant to the practice in § 2287 should be undertaken with special dispatch.

If the'586 reexamination proceeding is concluded by the issuance and publication of an *Ex Parte* Reexamination Certificate, the '484 patent would be modified by any change effected via the certificate. The '484 patent, as modified by any issued *Ex Parte* Reexamination Certificate, would be the patent that is surrendered (as required by statue) in favor of any reissue patent ultimately resulting from the '981 reissue application.

CONCLUSION

1. The merged proceeding consisting of the '981 reissue application and the '586 *ex parte* reexamination proceeding is hereby severed into (1) a separate proceeding, the '981 reissue application, for reissue of the '484 patent, and (2) a separate proceeding, the '586 *ex parte* reexamination, for reexamination of the '484 patent. The two proceedings will be carried on separately and concurrently.

2. Jurisdiction over the '586 reexamination proceeding is being returned to the Technology Center for immediate action on the proceeding by the primary examiner, toward resolution of the proceeding.

3. The '981 reissue application is being forwarded to the Board for any action deemed appropriate with respect to the "Predecisional Memorandum Suggested Interference Referral".

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[4] A thirty-day action may be promulgated requiring patent owner to eliminate any broadening that is present. It should be noted that restoring the claims in the '692 reexamination proceeding to the claims as they appear in the '484 patent would be one way to overcome the problem of broadened claims, if any exist.

4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

June 7, 2006
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